

REMARKS

The Examiner rejected claims 1-32 as obvious (35 U.S.C. §103) over Dedrick (U.S. Patent No. 5,717,923) in view of Tackbary (U.S. Patent No. 5,555,496). Applicants traverse the rejection for the following reasons.

Independent claims 1, 12, and 22 concern generating output material. The claims require generating a customer record in a first database table to include fields specifying at least one product, customer preferences, and a selected output method to deliver generated output material on the product specified in the customer record. At least one customer record in the first database table is received to process. At least one content file is accessed by processing a second database table using values in one received customer record. The content of each accessed file is generated into the output material. A determination is then made of one of a plurality of delivery options from the customer record and the output material is transmitted via the determined delivery option to the customer specified in the customer record.

In responding in the Final Office Action to Applicants arguments in the previous Amendment dated January 14, 2002, the Examiner cited col. 16, lines 23-32, col. 4, lines 11-23, and col. 14, lines 60-64 of Dedrick as teaching the claim requirements of independent claims 1, 12, and 22. (Office Action, pg. 2) Applicants traverse and submit that no section of the cited Dedrick anywhere discloses the specific claim requirements of accessing at least one content file by querying a second database table using values received in one customer record in a first database table, and then generating the content of each accessed file in the received output material.

The cited col. 16, which references FIGs. 7a and 7b, discusses how in response to a user request for advertising information at block 214, a metering server transfers the advertisement and records profile data of the user who requested the advertisement. Nowhere does this cited section teach or suggest the specific claim requirement of accessing at least one content file by querying a second database table using values from a customer record. In fact, this cited col. 16 of Dedrick teaches away from the claim requirement because in the cited Dedrick the content or advertisement is sent to the user before the user profile information is accessed. Thus, in the

cited Dedrick, the user profile information is not used to access a content file and generate the output advertisement sent to the user. The user profile information in the cited Dedrick is only recorded to keep track of which users were requesting advertisements. In the cited Dedrick, the user profile information is not accessed to use profile values to query a second database table to access at least one content file to output as claimed.

The cited col. 4, lines 11-23 of Dedrick discusses tools to allow an advertiser to create electronic information including content and advertisements. This electronic information may allow an end user to access a content database. Although this cited Dedrick does mention accessing a content database, nowhere does this cited section anywhere suggest or remotely mention accessing a content file by querying a second database with values in one received customer record.

The cited col. 14, lines 60-64 of Dedrick mentions that an interactive process may allow an end user to answer queries and take paths to external data. Although this cited section discusses using queries to access data, nowhere does this cited section anywhere suggest or remotely mention accessing a content file by querying a second database with values in one received customer record.

Thus, the cited Dedrick does not teach or suggest the claim requirements for which it was cited.

The Examiner cited col. 9, lines 7-15, FIG. 5, and the Abstract of Tackbary for the claim requirement of transmitting the output material via a selected delivery option. The cited col. 9, lines 7-15 discusses a mail mode box to allow a user to electronically select a method by which a the card is sent. The cited FIG. 5 shows a card dialog box in which the user can view information about the status of a card event and recipient..

Although the cited Tackbary discusses electronically storing information to include in a greeting-type card, the independent claims 1, 12, and 22 require that the delivery options are stored in a customer record whose values are used to query a second database to determine the content to generate into the output material. Nowhere does the cited Tackbary nor Dedrick teach the combination claim requirement of storing the delivery option in a customer record whose

values are used to query a database to access the content for the output material. The Examiner does not cite any art that suggests such a claimed combination and, thus, is proposing modifications to the cited prior art that are nowhere taught or suggested in the cited art.

Applicants submit that the case law is very clear that just because one can readily modify the prior art to produce the claimed combination does not make the claimed combination obvious unless the Examiner can provide some objective reference teaching or suggesting the claimed combination. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In *re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984) See also, the Manual of Patent Examination and Procedure Section (MPEP) Sec. 2143.01, pgs. 2100-123 to 125 (8th Ed., Aug. 2001) In *Gordon*, the mere fact that the prior art device could have been turned upside down to produce the claimed device was not sufficient to render the claimed combination obvious. Here, the claimed combination is not just rearranging a single prior art reference, as was the case in *Gordon*, but instead includes claim requirements, such as accessing a content file by querying a second database table using values in one received customer record and transmitting the output material via a delivery option indicated in the customer record that are nowhere remotely suggested in the cited art.

Applicants further note that even modifications that may appear simple cannot be made unless the Examiner provides suggestion or motivation to make the apparent "simple" modification. According to the Federal Circuit,

In a proper obviousness determination, "[w]hether the changes from the prior art are 'minor', . . . the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee's . . . device." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 935, 15 USPQ2d 1321, 1324 (Fed. Cir.), cert. denied, 498 U.S. 920 (1990). This includes what could be characterized as simple changes, as in *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down.).

In re Chu, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995) (emphasis added)

Here, the Examiner has not offered any objective evidence of a suggestion or motivation in the art for the claim requirements of accessing a content file by querying a second database table using values in one received customer record and transmitting the output material via a delivery option indicated in the customer record.

Applicants further submit that because the cited art does not suggest the specific claimed combination, the Examiner's suggested modifications of the cited art constitute improper use of hindsight. The U.S. Court of Appeals for the Federal Circuit has made clear that some objective teaching of the suggestion or motivation to combine prior art references is needed. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.") Here, the Examiner is engaging in improper use of hindsight to justify the proposed modification because the Examiner has not provided any objective teaching to support the proposed modification of the cited art.

For all the above reasons, Applicants submit that claims 1, 12, and 22 are patentable over the cited Dedrick and Tackbary.

Claims 2-11, 13-21, and 23-32 are patentable over the cited art because they depend from claims 1, 12, and 22, which are patentable for the reasons discussed above.

Applicants further submit below the arguments made in the previous Amendment dated January 14, 2002 to refute the rejections with respect to claims 3, 5, 7-11, 14, 16, 18-22, 24, 26, and 28-32, where such claims provide additional grounds of patentability over the cited art. Further, in the Final Office action, the Examiner only responded to Applicant's arguments in the previous Amendment with respect to dependent claims 3, 14, and 24, but not any of the other dependent claims Applicants specifically argued. Applicants request that the Examiner respond to Applicants arguments specifically explaining why the cited art does not teach or suggest the requirements of claims 5, 7-11, 16, 18-22, 26, and 28-32, which the Examiner did not address in the Final Office Action.

Claims 3, 14, and 24 depend from claims 1, 12, and 22 and further require that generating the customer records comprises executing a mining program against a database including customer information to determine information to populate at least one customer record from the customer. The Examiner cited col. 1, line 37 to col. 2, line 15 of Dedrick as teaching the additional requirement of these claims (Office Action, pg. 5). Applicants traverse.

The cited col. 1, line 37 to col. 2, line 15 of Dedrick discuss how electronic information providers desire large amounts of information about their markets, such as demographic characteristics of consumers. The cited section further discusses customizing electronic information to individuals based on there previous actions. The cited col. 2 discusses a personal profile database storing consumer information. A content adaptor compares electronic info received by the client system to consumer information in the personal profile database and customize the electronic info to the individual based on the comparison.

Nowhere does the cited Dedrick discuss executing a mining program to mine a data base including customer information to determine information to use to populate one customer record. Instead, the cited Dedrick discusses how information from a personal profile database is used to customize info sent to the individual, not how a database is mined to determine information to add to a customer record as claimed.

According, claims 3, 14, and 24 provide additional grounds of patentability over the cited art.

Claims 5, 16, and 26 depend from claims 4, 15, and 25 (which require that the delivery options include electronic mail, facsimile and postal mail) and further require automatically transforming the output material to a format compatible with the selected delivery option, wherein a different format is used for each delivery option, The transformed output is transmitted to the customer via the selected delivery option. The Examiner cited col. 1, line 37 to col. 2, line 15 and col. 6, lines 33-52 of Dedrick as teaching the additional requirements of these claims. (Office Action, pg. 5)

As discussed, the cited col. 1, line 37 to col. 2, line 15 discusses how information to transmit to an individual may be customized with personal profile information for the individual.

The cited col. 6, lines 33-52 further discusses how content to the individual may be customized with information for the individual from a personal profile database.

The cited col. 6, further discusses how the content adaptor may deliver electronic information in a format specified in the personal profile database. Although the cited Dedrick discusses generating content in different media formats, e.g., video or audio, this is different from the claim requirement of transforming output material to a format compatible with a selected delivery option, e.g., fax, mail, e-mail etc. Dedrick does not teach that the media formats concern a format compatible with a selected delivery option specifying how the content is transmitted. Thus, nowhere do these cited sections of Dedrick anywhere teach or suggest the claim requirement of automatically transforming output material to a format compatible with a selected delivery option. Further, nowhere does Dedrick suggest the claim requirement that a different format is used for each delivery option. Instead, Dedrick just discusses how the content may be generated in different media formats. The Examiner has not cited any part of Dedrick linking the different media formats to specific delivery options. Accordingly, claims 5, 16, and 26 provide additional grounds of patentability over the cited art.

Claims 7, 18, and 28 depend from claims 4, 15, and 25 (which require that the delivery options include electronic mail, facsimile and postal mail) and further require that the output material is automatically transmitted using one of the selected delivery options after generating the output material and further automatically printed for subsequent postal mailing to a customer street address. The Examiner cited col. 1, line 37 to col. 2, line 15, col. 6, lines 47-52, and the Abstract of Dedrick as teaching the additional requirements of these claims. (Office Action, pg. 5) Applicants traverse.

As discussed, the cited cols. 1 and 2 of Dedrick discuss how user information may be customized. The cited col. 6, lines 47-52 mentions how a default format may be video, but the personal profile database may indicate an alternative media format to use instead of a default format. As discussed, Dedrick's discussion of generating content into different media formats, e.g., audio and video, nowhere suggests or concerns the claim requirement of transmitting output using a selected delivery option. Moreover, nowhere do the cited sections of Dedrick teach or

suggest the claim requirement that the output material is printed and mailed after being automatically transmitted using the selected delivery option.

Accordingly, claims 7, 18, and 28 provide additional grounds of patentability over the cited art.

Claims 8, 19, and 29 depend from claims 1, 12, and 22 and further require processing a template including queries of records in the second database table. Accessing at least one file using values in one received customer record comprises accessing at least one value in a field in one customer record to include in a query against the second database table and applying the query against the second database to determine a record associated with a file including fields matching the query. The accessed file is associated with the determined record. In such case, generating the content into the output material comprises generating the content into the template, which forms the output material.

The claims 8, 19, and 29 require accessing a file using values in one customer record from the first database table to include in a query against the second database table to determine a record associated with a file such that the accessed file generated into the content is associated with the determined record.

No cited section of Dedrick teaches the claim requirement of using a value from a customer record in the first database table field to include in a query against the second database table. Instead, the cited col. 1, line 37 to col. 2, line 15 discusses how content may include information from a personal profile database. Further, nowhere is there any teaching in the cited Dedrick of the claim requirement of generating content by using customer information from a first database table to query a second database table to determine a record, and then determine a file associated with the record to include in the content as claimed.

Further, the cited col. 14, lines 55-64 discusses how a end user may search and review ads from an advertising content database, and answer queries and take alternate paths to external databases. Nowhere does this cited section concern generating content by using values from a customer record in a first database table to query a second database table.

The Examiner took Official Notice that processing a template is well known in the art. Although processing templates are well known in the art in general, the claims concern processing templates that include queries of records in a second database table, such that the queries use values from a customer record in a first database table to query a second database table to locate records that correspond to content files to generate into the template. Applicants submit that there is no such teaching in the cited art of the claimed query technique for adding content to templates.

Accordingly, Applicants submit that claims 8, 19, and 29 provide additional grounds of patentability over the cited art.

Claims 9, 20, and 30 depend from claims 8, 19, and 29 and further require that there are multiple files for each query, wherein the records associated with the files for each query have different values in at least one field, and wherein determining the record comprises determining the record from the files associated with the query that matches the search criteria.

The Examiner cited the same sections of Dedrick cited with respect to claims 8, 19, and 29. (Office Action, pg. 6) Applicants traverse because the cited Dedrick nowhere teaches or suggests the additional claim requirements that there are multiple files whose content will be added for a query. Instead, the cited Dedrick just discusses substituting content from a personal profile database into information to return. Nowhere is there suggestion that the content to include comprises multiple files associated with a query result as claimed.

Accordingly, claims 9, 20, and 30 provide additional grounds of patentability over the cited art.

Claims 10, 21, and 31 depend from claims 9, 20, and 30 and further require that each query is maintained in a container in the template and that the file having the associated record that matches the query is generated into the container. The appearance of the file content generated into the containers is resized in the output material. The Examiner cited the same sections of Dedrick discussed above with respect to claims 10, 21, and 31. (Office Action, pg. 6)

Applicants submit that nowhere does the cited Dedrick teach or suggest that a file associated with a record that matches a query is generated into the container. Instead, the cited Dedrick just discusses how data from a personal profile database may be added to content. Dedrick does not teach or suggest adding content from a file associated with a record as claimed. Moreover, claims 10, 21, and 31 require resizing the appearance of the output material. Nowhere does the cited Dedrick suggest resizing the appearance of output material in the template.

Claims 11, 22, and 32 depend from claims 9, 20, and 30 and further require accessing data from the customer record to insert into the text generated into the container from the accessed file generated into the container. Again the Examiner cites the same sections of Dedrick. (Office Action, pg. 6).

Claims 11, 22, and 32 require generating data from the customer record into text generated from a file resulting from a query on the second database table. Thus, in claims 11, 22, and 32, the data from the customer record is used twice, once in a query of a second database table to return a content file to generate into the template and second time to include in the content from the file. The cited Dedrick nowhere discusses such use of customer data from a customer record to query a second table and return a file of content and then add data from the same customer record into the content from the accessed file. Accordingly, claims 11, 22, and 32 provide additional grounds of patentability over the cite dart.

Conclusion

For all the above reasons, Applicants submit that the pending claims 1-32 are patentable over the art of record. Nonetheless, should any additional fees be required, please charge Deposit Account No. 50-0585.

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The attorney of record invites the Examiner to contact him at (310) 553-7977 if the Examiner believes such contact would advance the prosecution of the case.

Dated: June 18, 2002

By: 

David W. Victor
Reg. No.: 39,867

Please direct all correspondences to:

David Victor
Konrad Raynes Victor & Mann, LLP
315 South Beverly Drive, Ste. 210
Beverly Hills, CA 90212
Tel: 310-553-7977
Fax: 310-556-7984